

REMARKS

Claims 12-23 are all the claims pending in the application.

By this Amendment, Applicant amends claims 13-22 to cure minor informalities, and adds claim 23 which is clearly supported by the specification. No new subject matter has been entered. The amendment to claims 13-22 is made for reasons of precision of language and consistency, and does not narrow the literal scope of the claims and thus does not implicate an estoppel in the application of the doctrine of equivalents.

I. Preliminary Matters

Applicant thanks the Examiner for considering the references listed on form PTO/SB/08 submitted with the Information Disclosure Statement filed on May 25, 2006 and accepting the drawings also filed on May 25, 2006.

II. Summary of the Office Action

Claims 12-14 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kashihara (U.S. Patent No. 6,236,557).

Claims 15, 16, 18 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kashihara (U.S. Patent No. 6,236,557) in view of Adachi (U.S. Patent No. 5,550,415).

Claim 19 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kashihara (U.S. Patent No. 6,236,557) in view of Adachi (U.S. Patent No. 5,550,415), and further in view of Nikawa (U.S. Patent No. 6,291,913).

Claims 20 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kashihara (U.S. Patent No. 6,236,557) in view of Nikawa (U.S. Patent No. 6,291,913).

III. Amendments to Specification

Specification has been amended to correct minor informalities. No new subject matter has been entered.

Further, Applicant notes that the amendments to the specification submitted in the Preliminary Amendment filed May 25, 2006 are not reflected in the Patent Application Publication. Applicant requests confirmation of the entry of the amendments to the specification as submitted in the Preliminary Amendment filed May 25, 2006.

IV. Prior Art Rejections

Claims 12-14 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kashihara (U.S. Patent No. 6,236,557). Applicant respectfully traverses.

Claim 12 recites among other elements: “said voltage regulator, said surge absorber, and said connector are disposed radially outside said slinger alongside said brush holder on a first circumferential side of said brush holder.”

1. Kashihara lacks the voltage regulator disposed radially outside the slinger alongside the brush holder on a first circumferential side of the brush holder

Kashihara describes a voltage control function portion 20 made from a synthetic resin and provided in the first resin part 15 at the rear of the brush holder 17, to which a voltage regulator 21 is attached. (Col. 1, lines 51-59.) As clearly seen in Figs. 2 and 10, the voltage regulator has a wider circumferential width than the brush holder and overlaps with the brush holder to project beyond the brush holder on first and second circumferential sides. Thus, Kashihara teaches a voltage regulator that is disposed at a rear side of the brush holder and proximate to both first and second circumferential sides of the brush holder. Kashihara does not teach or suggest a voltage regulator that is disposed alongside the brush holder and proximate to only the first circumferential side of the brush holder.

2. Kashihara lacks the surge absorber disposed radially outside the slinger alongside the brush holder on a first circumferential side of the brush holder

Kashihara teaches the capacitor which is installed on one side of the slinger, projecting sideways from the slinger and the brush holder. (Col. 2, lines 22-27.) Kashihara does not teach or suggest the capacitor or surge absorber that is disposed alongside the brush holder and proximate to only the first circumferential side of the brush holder.

3. Kashihara lacks the connector for input and output to an external device

It is alleged in the Office Action that Kashihara discloses connector for input and output to an external device in Fig. 10. Applicant carefully reviewed Fig. 10 and the rest of Kashihara and did not find any teaching or suggestion of a connector for input and output to an external device. If Examiner maintains that Kashihara teaches a connector for input and output to an external device, to determine the scope of Kashihara regarding the connector position and orientation, Applicant respectfully requests the Examiner to point out which exact element in Fig. 10 the connector is or exactly where else in Kashihara the connector for input and output to an external device is disclosed.

4. Positioning the voltage regulator, surge absorber, and connector radially outside the slinger alongside the brush holder on a first circumferential side of the brush holder is not obvious

Initially, Applicants submit that there is no suggestion or motivation in Kashihara or in the knowledge generally available to one skilled in the art at the time the invention was made to modify Kashihara to position the voltage regulator, surge absorber, and connector radially outside the slinger alongside the brush holder on a first circumferential side of the brush holder.

a. The proposed modification would render Kashihara unsatisfactory for its intended purpose

Kashihara is directed to a capacitor for a car AC generator which improves assembly work efficiency and reduces a vibration load on the connection portions of the element terminals of the capacitor element and the terminals of the resin part, wherein a resin part installed in the inside space of a generator case has a one-end open bottomed cylinder-like container portion and resin side terminals around the opening portion of the container portion. (Abstract.) Accordingly, Kashihara's invention is directed to positioning the capacitor in a certain manner in a certain container proximate to the slinger and providing the terminals for the capacitor to connect to other components. Rearranging the location of the capacitor, therefore, will defy the

entire purpose of Kashihara's invention. Accordingly, the entire subject of Kashihara's invention will lack its intended purpose. Therefore, it is not understandable (nor is the proper reasoning provided in the Office Action) why one skilled in the art would have desired so to modify Kashihara to arrive at the subject matter of claim 12.

b. The Examiner uses an impermissible hindsight

Applicant submits that the Examiner's conclusion of obviousness is based on improper hindsight including only the knowledge gleaned from the Applicant's own disclosure. However, "[i]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." (See MPEP § 2142)

The Examiner has formulated grounds of rejection which, at first blush, appear to be based on actual prior art disclosure, but instead are based on a hindsight rationale that anyone who is familiar with alternators could have positioned the voltage regulator, surge absorber, and connector radially outside the slinger alongside the brush holder on a first circumferential side of the brush holder. The Examiner provides no objective evidence substantiating his position.

c. It is not obvious to rearrange the voltage regulator, surge absorber, and connector for the purpose of increasing the cooling efficiency

It is alleged in the Office Action that it would have been obvious "to rearrange the voltage regulator, surge absorber, and connector for the purpose of increasing the cooling efficiency." (See page 3.) Applicant respectfully disagrees. Applicant was first to discover that rearranging the voltage regulator, surge absorber, and connector would substantially improve cooling as described, for example, in the specification, on page 2, lines 11-22, and page 24, lines 1-7. The Examiner's position is based on Applicant's disclosure and is not rooted in the prior art of record. Furthermore, since an exemplary rearrangement improves the cooling efficiency, as discovered by the Applicant, the exemplary arrangement cannot be a matter of obvious design choice.

In summary, (1) because Kashihara does not teach or suggest at least "said voltage regulator, said surge absorber, and said connector are disposed radially outside said slinger

alongside said brush holder on a first circumferential side of said brush holder,” and (2) because there is no suggestion or motivation in Kashihara or in the knowledge generally available to one skilled in the art at the time the invention was made to modify Kashihara to position the voltage regulator, surge absorber, and connector radially outside the slinger alongside the brush holder on a first circumferential side of the brush holder, **claim 12 and dependent claims 13-22** distinguish patentably and unobviously over Kashihara.

Claims 15, 16, 18 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kashihara (U.S. Patent No. 6,236,557) in view of Adachi (U.S. Patent No. 5,550,415).

Claims 15, 16, 18 and 22 depend on claim 12. Applicant have already demonstrated that Kashihara does not meet all the features of independent claim 12. Adachi does not compensate for the above-identified deficiencies of Kashihara. Together, the combined teachings of these references would not have (and could not have) led the artisan of ordinary skill to have achieved the subject matter of claim 12. Since **claims 15, 16, 18 and 22** depend on claim 12, they are patentable at least by virtue of their dependency.

Claim 19 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kashihara (U.S. Patent No. 6,236,557) in view of Adachi (U.S. Patent No. 5,550,415), and further in view of Nikawa (U.S. Patent No. 6,291,913).

Claim 19 depends on claim 18. Applicant have already demonstrated that Kashihara and Adachi do not meet all the features of claim 18. Nikawa does not compensate for the above-identified deficiencies of these references. Together, the combined teachings of these references would not have (and could not have) led the artisan of ordinary skill to have achieved the subject matter of claim 18. Since **claim 19** depends on claim 18, claim 19 is patentable at least by virtue of its dependency.

Claims 20 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kashihara (U.S. Patent No. 6,236,557) in view of Nikawa (U.S. Patent No. 6,291,913).

Claims 20-21 depend on claim 12. Applicant have already demonstrated that Kashihara does not meet all the features of independent claim 12. Nikawa does not compensate for the above-identified deficiencies of Kashihara. Together, the combined teachings of these references would not have (and could not have) led the artisan of ordinary skill to have achieved the subject matter of claim 12. Since **claims 20-21** depend on claim 12, they are patentable at least by virtue of their dependency.

III. New Claims

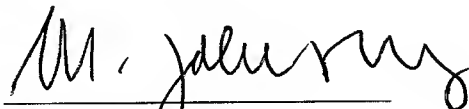
In order to provide more varied protection, Applicant adds **claim 23**. Claim 23 is patentable at least for analogous reasons set forth above with respect to claim 12. No new subject matter has been entered.

CONCLUSION

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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23373

CUSTOMER NUMBER

Date: May 30, 2008